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| APPLICATION NO.                          | FILING DATE | FIRST NAMED INVENTOR    | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-------------------------|---------------------|------------------|
| 10/565,955                               | 01/26/2006  | Lutz Wolfgang Gruneberg | 051082              | 8456             |
| 20306                                    | 7590        | 12/04/2008              | EXAMINER            |                  |
| MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP |             |                         | KARIKARI, KWASI     |                  |
| 300 S. WACKER DRIVE                      |             |                         | ART UNIT            | PAPER NUMBER     |
| 32ND FLOOR                               |             |                         | 2617                |                  |
| CHICAGO, IL 60606                        |             |                         |                     |                  |

  

|            |               |
|------------|---------------|
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                              |                                      |
|------------------------------|------------------------------|--------------------------------------|
| <b>Office Action Summary</b> | <b>Application No.</b>       | <b>Applicant(s)</b>                  |
|                              | 10/565,955<br>KWASI KARIKARI | GRUNEBERG ET AL.<br>Art Unit<br>2617 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09/03/2008.  
 2a) This action is **FINAL**.                  2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-15 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 09/03/2008 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____ .                        |

**DETAILED ACTION**

**Response to Arguments**

1. Applicant's arguments, filed on 09/03/2008 with respect to claims 1-15 in the remarks, have been considered but are moot in view of the new ground(s) of rejection necessitated by the new limitations added to the pending claims. See the rejection below of the pending claims for relevant citations found in Cover disclosing the newly added limitations.

**Claim Rejections - 35 USC § 102**

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 4-10 and 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Cover et al. (Cover) (US 7,155,479 B2).**

**As per claim 1:** Cover discloses a system for handling email requests for sending and receiving email from a terminal (= telephonic device 300/consumer, sends identifier to domain server 360 and redirects the identifier to server 361C which stores

electronic email, see col. 4, lines 51-61; col. 10, lines 48-60; and col. 12, lines 2-51), the system comprising;

at least one email proxy (= logical communication path may include hardware components such as proxies, router and gateways, see col. 7, lines 14-22 and domain server 360 and redirects the identifier to server 361C which stores electronic email), and a database (= configuration information may be contained in a searchable table or database, see col. 7, lines 55-64), the email proxy being arranged to communicate with the database (= domain server 360 and redirects the identifier to server 361C which stores electronic email see col. 2, line 61-col. 3, line 22),

wherein the email proxy is arranged to detect a network address of the terminal (see col. 2, lines 41-60; col. 9, line 61-col. 10, line 5), and retrieve email configuration settings from the database (see col. 7, line 55-col. 8, line 8), using the network address of the terminal (= device 300 sends identifier, see col. 8, lines 49-67; col. 9, lines 11-24; and col. 10, lines 48-60),

the email proxy further being arranged to communicate with an email server, using the retrieved email configuration settings/values (= server 380 may receive request for configuration information electronic email domain may include a plurality of server, see col. 10, lines 42-60; col. 12, lines 2-42; col. 13, lines 3-15; col. 14, line 25-col. 15, line 42). Cover also discloses that a central sever could include LDAP (see col. 1, lines 50-64).

**As per claim 4:** as recited in claim 1, Cover discloses the system, wherein the database comprises a mapping of the network address of the terminal to an identity of a user (see col. 8, line 49-col. 9, line 10; col. 7, line 55-64; col. 8, lines 23-37).

**As per claim 5:** as recited in claim 4, Cover discloses the system, wherein a first database comprises the mapping of the network address, of the terminal to the identity of the user (see col. 9, lines 1-10; col. 10, lines 39), and a second database (1 O) comprises the email configuration settings/values (see col. 8, lines 23-37).

**As per claim 6:** as recited in claim 1, Cover discloses the system, wherein a first email proxy is used to handle email requests for retrieving email messages (see col. 14, lines 27-62), and a second email proxy is used to handle email requests for sending email messages.(see col. 15, lines 27-42).

**As per claim 7:** some of the features of claim 7 are similar to the features of claim 1 and are rejected on the same ground as claim 1. Cover discloses the difference features --- forwarding the email retrieval request to an email server using the email configuration settings/values/attributes (see col. 14, line 27-col. 15, line 15), retrieve a requested email message from the email server and forwarding the requested email message to the terminal (see col. 15, lines 26-50).

**As per claim 8:** some of the features of claim 8 are similar to the features of claim 1 and are rejected on the same ground as claim 1. Cover also discloses the difference features --- modifying the email request using the email configuration settings (values/attributes) and forwarding the modified email sending request to an email server using the configuration settings (values/attributes) (see col. 8, lines 59-67).

**As per claim 9:** Cover discloses a terminal for use with a system, the terminal being provisioned with default configuration settings for sending or retrieving email messages, the default configuration settings being the same for mobile terminals within a network (see col. 15, lines 4-15, wherein the mobile terminal is arranged to send or retrieve email messages using the default configuration settings (see col. 5, lines 26-39).

**As per claim 10:** the features of claim 10 are similar to the features of claim 1, except claim 10 is broader than claim 1. Besides, claim similarity, the specific reads on the broad. Thus, claim 10 is rejected on the same ground as claim 1.

**As per claim 13:** the feature of claim 13 is similar to the feature of claim 4. Hence, claim 13 is rejected on the same ground as claim 4.

**As per claim 14:** the feature of claim 14 is similar to the feature of claim 5. Hence, claim 14 is rejected on the same ground as claim 5.

**As per claim 15:** the feature of claim 15 is similar to the feature of claim 6.

Hence, claim 15 is rejected on the same ground as claim 6.

**Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2-3 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cover as applied to claims 1 and 10 above, and further in view of applicant's admitted prior art (APA).**

**As per claim 2:** as recited in claim 1, Cover does not explicitly teach about email configuration settings including -- a name of an email server, and a username and a password for accessing the email server, as claimed by applicant. However, applicant in, in the same field of endeavor, teaches that -- a name of an email server, a user name and a password are known to be used for email retrieval (see page 2, lines 1-4. (7). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Cover with the using --- a name of an email server, a user name and a password are known to be used for email retrieval is known in the art as evidenced by applicant's use of the same.

**As per claim 3:** Cover does not explicitly teach the system, wherein the email configuration settings further include: a full name of a user and an email address of the user.

APA teaches the system, wherein the email configuration settings further include: a full name of a user (see page 2, lines 16-20), and an email address of the user (see page 2, lines 16-20). A name includes a full name because the APA doe not exclude any part of a name. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Cover with the using --- a full name of a user and an email address of the user known to be used for email retrieval is known in the art as evidenced by applicant's use of the same.

**As per claim 11:** the features of claim 11 are similar to the features of claim 2. Hence, claim 11 is rejected on the same ground and motivation as claim 2.

**As per claim 12:** the features of claim 12 are similar to the features of claim 3. Hence, claim 12 is rejected on the same ground as claim 3.

## **CONCLUSION**

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to

specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. SEE MPEP 2141.02 [R-5] VI. PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS: A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). >See also MPEP §2123.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of 33the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2617

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-T (9am - 7pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571-272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8566. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patent Examiner Art Unit 2617.

/Charles N. Appiah/  
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